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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,720	10/29/2001	Aaron Dew	50R4792	2640
7590	12/12/2005		EXAMINER	
Rogitz & Associates Suite 3120 750 B Street San Diego, CA 92101			PARRY, CHRISTOPHER L	
			ART UNIT	PAPER NUMBER
			2614	
DATE MAILED: 12/12/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/003,720	DEW ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Chris Parry	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 October 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
  - 4a) Of the above claim(s) 19-20 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 October 2001 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-18, drawn to establishing a TV channel based on location of the TV, are classified in class 725, subclass 39.
  - II. Claim 19, drawn to targeting advertising based on geographical location, is classified in class 725, subclass 35.
  - III. Claim 20, drawn to generating program recommendations based on location of the TV, is classified in class 725, subclass 46.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II, III, and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as, TV channels, can be established by using the location of the TV inputted either by the user or a global positioning satellite. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. John Rogitz on December 7, 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-18. Affirmation of this election must be made by applicant in replying to this

Office action. Claims 19-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

6. The abstract of the disclosure is objected to because the form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. Correction is required. See MPEP § 608.01(b).

7. The disclosure is objected to because of the following informalities: On page 10, line 11, the examiner is not clear on whether "precording" should be --prerecording--. Appropriate correction is required.

### ***Claim Objections***

8. Claim 1 is objected to because of the following informalities: Line 2 of Claim 1, "porgram" should be --program--. Appropriate correction is required.

9. Claim 6 is objected to because of the following informalities: Claim 6 recites the limitation "heuristics" in line 19. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-2, 4-12, 14-15, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Staron (U.S. 5,805,230).

Regarding Claim 1, Staron discloses a system for automatically programming a tuner by using the zip code inputted by the user (Abstract). Staron teaches, "a system for automatically establishing at least one TV channel...based on at least one of: a geographic location of a TV...comprising: a TV" by disclosing in figure 3, the user enters his ZIP code using an interface device 41 of known type including a control keypad and an infra-red transmitter and receiver. The microprocessor 38 starts the automatic programming method described above with reference to FIG. 2, receiving the special data via the bus 40. It programs the tuner via the bus 39 (Col. 5, lines 35-53). Staron teaches, "a processor coupled to the TV and receiving information representative of at least one of: a geographic location of a TV, the processor establishing at least one channel based at least partially thereon" by disclosing the microprocessor 38 or "processor" starts the automatic programming or "establishing at least one channel" method described above with reference to FIG. 2 by using the zip code entered by the user (Col. 5, lines 35-53).

As for Claim 2, Staron teaches, “wherein the information is input by a viewer of the TV” by disclosing the user enters his ZIP code using an interface device 41 (Col. 5, lines 47-48).

As for Claim 4, Staron teaches, “wherein the processor accesses a set of heuristics to undertake the establishing act” by disclosing a user will enter a zip code and the TV receiver using the zip code can then, by means of criteria indicating the quality of the reception, automatically choose the channel table whose data provide the best reception (Col. 3, lines 1-20).

As for Claim 5, Staron teaches, “an input device manipulable to establish the channels” by disclosing user interface 41 shown in figure 3 (Col. 5, lines 35-53).

As for Claim 6, Staron teaches, “wherein manually input channels are used by the processor to alter the heuristics” by disclosing to alter or receive the channel line up, the user enters a new zip code using user interface 41 (Col. 4, lines 23-29).

Regarding Claim 7, Staron discloses a system for automatically programming a tuner by using the zip code inputted by the user (Abstract). Staron teaches, “a method for establishing at least one TV channel on a TV based on at least one of: location of the TV...” by disclosing when a user switches on his TV (20), a message is displayed asking the user to enter his zip code or “location”. The tuner of the TV then scans the channel frequencies to identify the channels that can be received that correspond to the zip code provided (Col. 3, line 47 – Col. 4, line 22). Staron teaches, “providing a set of correlation heuristics” by disclosing the user enters his zip code, which is used to

identify channel tables in his area and the TV receiver can then by means of criteria or "set of correlation heuristics" indicate the quality of the reception by automatically choosing the channel table whose data provides the best reception (Col. 3, lines 1-20). Staron teaches, "receiving an input comprising at least one of: the location..." by disclosing the user enters his zip code when he switches the TV on (Col. 3, lines 47-49). Staron teaches, "accessing the set of correlation heuristics to correlate the input to the channel" by disclosing when a zip code corresponds to two or more channel tables, the method can select only the table corresponding to the best reception. It does this by systematically scanning all the data transmitted and recording the channel tables corresponding to the same zip code and the AGC levels of each of the channels and comparing the AGC levels (Col. 3, line 54 – Col. 4, line 22).

As for Claim 8, Staron teaches, "wherein the location is a location of the TV within a building" by disclosing the user enters his zip code of where his TV is located in his home or building (Col. 3, lines 41-49).

As for Claim 9, Staron teaches, "wherein the location is a geographic location of the TV" by disclosing the user enters his zip code using an interface device 41 (Col. 5, lines 47-48).

As for Claims 10 and 11, the claims are rejected as the claims fail to be further limiting of claim 7.

As for Claim 12, Staron teaches, “wherein the input is received from a viewer of the TV” by disclosing the user enters his zip code, which is then stored in memory (Col. 3, lines 47-52 and Col. 5, lines 47-49).

Regarding Claim 14, Staron discloses a system for automatically programming a tuner by using the zip code inputted by the user (Abstract). Staron teaches, “a system for tailoring TV channels to a TV location” by disclosing when a user switches on his TV (20), a message is displayed asking the user to enter his zip code or “location”. The tuner of the TV then scans the channel frequencies to identify the channels that can be received that correspond to the zip code provided (Col. 3, line 47 – Col. 4, line 22). Staron teaches, “means for inputting the location to establish an input” by disclosing a user enters his zip code using an interface device 42 as shown in figure 3 (Col. 5, lines 47-49). Staron teaches, “means for correlating the input to at least one channel associated with the TV” by disclosing microprocessor 38 automatically programs the tuner by using the received zip code entered by the user (Col. 3, line 54 – Col. 4, line 22 and Col. 5, lines 49-52). Staron teaches, “means for establishing the channel on the TV” by disclosing when the zip code entered by the user, lies between ZC<sub>1</sub> and ZC<sub>2</sub>, the channel table corresponding to this couple (ZC<sub>1</sub> ZC<sub>2</sub>) is sent to the tuner where it is used to program the channel table to memory (Col. 3, line 47 – Col. 4, line 9).

As for Claim 15, Staron teaches, “wherein the means for inputting is a human-manipulable TV control device associated with the TV” by disclosing user interface 41 shown in figure 3 (Col. 5, lines 35-53).

As for Claim 17, Staron teaches, "wherein the means for correlating is a processor located in the TV" by disclosing microprocessor 31 shown in figure 3 (Col. 5, lines 35-53).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Staron (U.S. 5,805,230).

As for Claim 18, Staron teaches a system where the processor is located in a television. However, Staron fails to explicitly disclose a system, wherein the means for correlating is a processor located in a set-top box associated with the TV. The examiner gives **Official Notice** that it is notoriously well known in the art for a TV to be coupled to a set-top box and to comprise a processor capable of automatically establishing channels and an electronic program guide based on location. Accordingly, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Staron in order for the system to have a processor located in a set-top box associated with the TV for the benefit of providing the necessary processing capabilities that a TV may not possess.

14. Claims 3, 13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staron (U.S. 5,805,230) in view of Bednarek et al. "Bednarek" (U.S. 6,009,119).

As for Claim 3, Staron fails to explicitly disclose wherein the information or "zip code" is received via a global positioning satellite. In a related art pertaining to video distribution, Bednarek teaches the use of an IRD set-top box 37 with means to receive GPS signals using antenna 36 as shown in figure 2. Bednarek further discloses using GPS coordinates to enable the process of descrambling a scrambled program. Bednarek discloses conditional access, which results in descrambling the program for use occurs (i.e., access is granted) when all of the following conditions are met:

1. The Region Code which accompanies scrambled programming must match the Region Index previously transmitted by the Service Provider and securely stored in the box.
2. The GPS must indicate, per the discussion relative to the parent application and as discussed for FIGS. 1-6 above, the Set-Top box has not been moved from its authorized location.
3. Other conditional access criteria, which includes the customer subscription to the particular programming and satisfactory account status.

Bednarek discloses GPS coordinates are supplied to the GPS processor 54 and the processor uses the current coordinates and compares to coordinates to the saved coordinates for the set-top box (Col. 17, lines 25-49). If the GPS coordinates do not match then it is determined that the set-top box has been moved to an unauthorized

position (Col. 10, lines 16-30 and Col. 11, lines 12-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Staron with the teachings of Bednarek in order for the processor to receive location information from a global positioning satellite for the benefit of getting a more accurate calculation of the position of the set-top box in order to facilitate receiving authorized programming (Bednarek – Background).

Considering Claim 13, the claimed elements of wherein the input is received from a global positioning satellite, corresponds with subject matter mentioned above in the rejection of claim 3, and is likewise treated.

Considering Claim 16, the claimed elements of wherein the means for inputting is a wide area source of data, corresponds with subject matter mentioned above in the rejection of claim 3, and is likewise treated.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents and publications are cited to further show the state of the art with respect to establishing channels and electronic program guides in TV.

U.S. Pat. No. 5,790,202 to Kummer et al.

U.S. Pat. No. 6,268,849 to Boyer et al.

U.S. Pat. No. 6,7546,997 to Ward III, et al.

U.S. Pat. No. 6,505,348 to Knowles et al.

U.S. Pat. No. 6,583,825 to Yuen et al.

U.S. Pat. No. 5,977,964 to Williams et al.

U.S. Pub. No. 2002/0042915 to Kubischta et al.

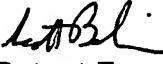
U.S. Pub. No. 2005/0251827 to Ellis et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Parry whose telephone number is (571) 272-8328. The examiner can normally be reached on Monday through Friday, 8:30 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner Initials: CR  
December 7, 2005

  
John Miller  
Patent Examiner  
Art Unit 2614